

REMARKS

Claims 1-27 are pending in the application. Claims 19-27 are withdrawn from consideration. Claims 1-18 are rejected.

SPECIFICATION:

The Examiner requests that antecedent basis be provided in the specification for the recitation of “varistors touch each other,” as recited in claim 1.

Applicant respectfully submits that this feature is shown, for example, in at least present Fig. 1, by the varistors 10 which are stacked and positioned adjacently so as to touch one another. The contacting areas of the varistors 10 can be seen through the adhesive 30 in Figure 1, for example. Nevertheless, to comply with the Examiner's request, Applicant amends page 7, line 33 of the specification to provide further antecedent basis for what is illustrated in the drawings and recited in claim 1. Withdrawal of the objection is respectfully requested.

35 U.S.C. § 112:

Claim 1 is rejected to under 35 U.S.C. § 112, second paragraph, because the Examiner asserts it fails to correspond in scope with the present specification. In particular, the Examiner notes that page 7, lines 34 and 35 of the specification recites “possibly with spacers being interposed between at least some adjacent pairs of varistors 10.” The Examiner is concerned that the claimed invention is different in scope than an exemplary embodiment described in the detailed description.

Applicant respectfully points out that the cited area of page 7 merely indicates a possible configuration of the varistors. The present specification includes various exemplary embodiments. One additional contribution provided by the inventor is a possible configuration

where spacers may be interposed between some adjacent varistors. However, the present disclosure does not require that spacers be provided between varistors.

Further, MPEP § 2172 indicates that the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which Applicants regard as their invention. Also, MPEP § 2172(II) indicates that the contents of Applicant's specification should not be used as evidence that the scope of the claims is inconsistent with the subject matter which Applicants regard as their invention. The portion cited by the Examiner (i.e. page 7, lines 34 and 35) forms part of Applicant's specification. Therefore, Applicant respectfully submits that the requirements of 35 U.S.C. § 112, second paragraph, are fulfilled such that the rejection of claim 1 should be withdrawn.

The Examiner rejects to claim 8 as being indefinite. Claim 8 is amended to depend from claim 6 to provide antecedent basis for the feature noted by the Examiner. Withdrawal of the rejection of claim 8 is respectfully requested.

35 U.S.C. § 102:

Claims 1-3, 5-14, 16 and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sakich et al. (U.S. Patent No. 5,926,356 [hereinafter "Sakich"]).

Sakich is applied for disclosing a surge arrestor including a stack of varistors 60 and 62. Elements 60 and 62 are explicitly disclosed as being separated by a contact disc 78, as shown in Fig. 2 and described in col. 4, line 27 of Sakich.

Without conceding to the grounds of rejection, Applicant points out at least one deficiency of Sakich. Claim 1 recites *inter alia*, "making a stack of varistors such that the varistors touch each other." Applicant respectfully submits that at least this feature is not

disclosed by Sakich. Instead, elements 60 and 62 of Sakich do not touch each other, but are instead separated by the disc 78 that forms a barrier between elements 60 and 62 and prevents contact therebetween. Moreover, Sakich does not describe an operation of depositing a bead of flexible, adhesive, and dielectric material on the previously formed stack at interfaces between each adjacent pair of varistors. The plastic film in Sakich does not disclose the claimed bead.

Accordingly, Applicant respectfully submits that Sakich fails to disclose each feature of claim 1, such that the rejection thereof under 35 U.S.C. § 102(b) should be withdrawn. Applicant also respectfully submits that the rejection of dependent claims 2, 3, 5-14, 16 and 17 should be withdrawn at least by virtue of their respective dependencies on claim 1.

35 U.S.C. § 103:

Claims 4 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakich et al.

The Examiner acknowledges that Sakich does not disclose the claimed bead width and thickness. The Examiner alleges that such a feature would be a matter of design choice. Applicant submits that one would not be motivated to modify Sakich to have the claimed features. If the Examiner disagrees, he is respectfully requested to provide the requisite support for establishing a *prime facie* case of obviousness. Nevertheless, the features of claim 1 are neither taught nor suggested by Sakich, such that claim 4 is patentable over this reference, at least by virtue of its dependency upon claim 1.

In regard to claim 5, the Examiner acknowledges that Sakich does not disclose the claimed resin content. Similar to above, Applicant respectfully submits that such a feature cannot merely be regarded as a “design choice” without the requisite motivational support found

in the references or art in general to support the rejection. Claim 15 is patentable over Sakich at least by virtue of its dependency upon claim 1.

Claim 18

Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakich in view of Helgeland et al. (U.S. Patent No. 3,645,784 [hereinafter "Helgeland"]).

The Examiner applies Helgeland for disclosing to coat a resistor to provide stress resistance. Applicant respectfully submits that the application of Helgeland fails to make up for the deficient teachings of Sakich, such that claim 1 is patentable over the combination of Sakich and Helgeland. Thus, claim 18 is deemed patentable at least by virtue of its dependency.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Patent Application No.: 10/690,829

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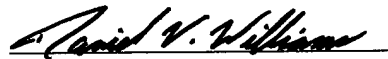
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